



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

IN RE APPLICATION

APPLICANT: Meryl Greenwald Gordon et al.

SERIAL NO.: 09/186,856

FILED: November 5, 1998

FOR: Multiplayer Electronic Games

GROUP ART UNIT: 3713

EXAMINER: B. NGUYEN

ATT'Y DOCKET: GOR-001

Honorable Commissioner of Patents
and Trademarks
Washington, D.C. 20231

Sir:

I hereby certify that this correspondence is being deposited on this day with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231.

Thomas A. Gallagher
Reg. No. 31,358

Date

APPLICANT'S REPLY BRIEF ON APPEAL

The Examiner filed an Answer to the Applicant's Brief on either September 16, 2002 or September 17, 2002¹. In accord with 37 CFR §1.193, this Reply Brief is timely filed on today's date regardless of the correct date of the Answer.

In the Answer, the Examiner raises several new arguments and introduces new evidence attempting to support the rejection. Although it is arguable that the Examiner has violated the

¹-The Examiner's Answer bears a stamp which states "Mailed SEP 16 2002 GROUP 3700" but is attached to a form PTO-90C which states that the Answer was mailed on 9/17/02.

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prohibition against entering new grounds of rejection², in the interest of expediency, the Applicant respectfully waives its right to reopen prosecution.

Page 5 of the Applicant's Substitute Brief states that "there are no related appeals or interferences." Therefore, the Examiner's comment at the top of page 2 of the Answer is not understood.

The Arguments presented in the Applicant's Brief are substantially the same as those presented during prosecution. In particular, the manner in which the Applicant analyzed the Examiner's rejection has always been the same, i.e. determine the teachings of references individually and then determine whether there is any incentive to combine the teachings. In the Answer, the Examiner argues for the first time that this is an incorrect analysis of an obviousness rejection. The Examiner states that the Applicant argued the references "individually, rather than in combination."³ Of course this is foolishness. It assumes ab initio that there is incentive to combine the references.

2-37 CFR §1.193(a)(2), MPEP §1208.01. See In re Kronig, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976). Where the statutory basis for the rejection remains the same, and the evidence relied upon in support of the rejection remains the same, a change in the discussion of, or rationale in support of, the rejection does not necessarily constitute a new ground of rejection. Id. at 1303, 190 USPQ at 427 (reliance upon fewer references in affirming a rejection under 35 U.S.C. 103 does not constitute a new ground of rejection).

³-Answer page 4.

The cases cited by the Examiner to support this "all at once" type analysis of an obviousness rejection are both based⁴ on the holding in In re Goepfrich, 58 U.S.P.Q. 324 (CCPA 1968). Over the years, the headnotes for the original principle seem to have been somewhat mangled. The original holdings were made in response to the specious argument that references could never be combined to make an obviousness rejection. In other words, it is not improper to analyze references individually, provided that one considers what combinations of the references is suggested. "The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference.... Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art." In re Keller, 208 U.S.P.Q. 871 at 881 (CCPA 1981). In this regard, there must be evidence of a suggestion to combine the references. In re Dembiczak, 50 USPQ2d 1614, (Fed. Cir. 1999).

The Examiner's stated reason why combining the references would have been obvious is "to create a better game". If this were adequate evidence of incentive to combine references, virtually every invention which is better than the prior art would

⁴-When one traces the citations back to their source, the earliest case upon which the Examiner's point may be derived is In re Goepfrich which derived its holding from the holding in In re Fridolph, 57 U.S.P.Q. 122 (CCPA 1943).

be obvious provided that all of the individual elements could be found in the prior art.

The Examiner's argument that a pin ball and a golf ball are equivalent to a player character in an adventure game⁵ is farfetched and no evidence is provided to support this conclusion of equivalence.

Many of the Applicant's comments regarding the prior art references are made to support the argument that the references themselves do not suggest their combination. Moreover, the Examiner has not provided any evidence outside of the cited references to suggest their combination. Thus, the Applicant's remarks regarding the Stamper et al. pinball art are provided to expose why the references are not likely to be combined as suggested by the Examiner.

The Examiners response to the Applicant's argument that golf simulators and video games are not analogous art is that they both use video technology so they are analogous. This is an interesting argument which the Examiner attempts to bolster with the suggestion that a video game creator might look to other video technologies for information about graphics processing and split

⁵-Answer page 5.

screen techniques.⁶ However, the present invention is not concerned with video processing; nor is it concerned with how to make a split screen in a video display. It is concerned with when to split a screen in a multi-player adventure game, not how to split a screen in any video display.

The Examiner's comments regarding motivation are difficult to understand. They seem to say that because the incentive "to make a better game" is the driving force in the industry, any making of a better game is therefore obvious. Clearly this cannot be true.

The Examiner's conclusion that the invention is directed to graphics processing is mistaken.⁷ As mentioned above, the split screen nature of the invention is related to game play and not to any particular video graphics processing technology. Moreover, if the inventor of an adventure game were motivated to look at non-specific video graphics processing technologies, one would fairly conclude that the inventor already knew what kind of video display the adventure game should have. The research into non-specific video technology might be undertaken after the invention were made to learn different ways of implementing the invention. It should be abundantly clear that the Examiner's analysis assumes that the decision to provide a split screen in an adventure game and when

⁶-Answer page 6.

⁷-Answer pages 6-7.

to provide it must have been known before one of ordinary skill would look to the non-adventure game art of graphics processing.

The Examiner's conclusion that the Applicant's arguments are not "commensurate in scope with appellant's claim language"⁸ is not explained. The only claim referred to by the Examiner is claim 1, but the rejection at hand concerns claims 2-5 and 20.

The Examiner's analysis of the "teleport box" of Naka et al.⁹ is pure speculation. Nowhere in Naka et al. is there any requirement for joint action. The so-called "cooperative mode" in Naka et al. is a training mode where a novice player can learn. It is not required. The Examiner admits that such is not a teaching of Naka et al. when he states that "it necessarily follows...".¹⁰ In other words, though Naka et al. makes no such teaching, it follows if you know what you are looking for.

As to the "automatic" switching of modes in Naka et al.¹¹, it is something of a misnomer. The so-called "automatic switching" takes place in response to "a determination ... as to whether the

8-Answer pages 7-8.

9-Answer page 8.

10-Answer page 9.

11-Answer page 9.

game has been set to be controlled by only one player."¹² The "setting" of the game is not automatic. Thus, although Naka et al. uses the word "automatic" is not the same kind of automatic switching as described and claimed in the present application.

The Examiner's arguments regarding claims 18¹³ and 19¹⁴ are curious. Claim 18 sets forth a number of types of cooperative action in a Markush group. The Examiner seems to say that the claim language "at least one" allows unclaimed matter to read on the claim. A similar argument is made regarding claim 19. Clearly, this is not the law.

At page 12 of the Examiner's Answer, four new pieces of "prior art" are introduced to explain what the term "adventure game" means. Before addressing each of these articles, it should be noted that the present application was filed November 5, 1998. Thus, it is questionable whether the article dated July 2001 is properly considered and the dates of the other articles are uncertain. Nevertheless, it appears that these articles support the Applicant's interpretation of the term "adventure game".

¹²-Naka et al. Col. 21, lines 45-50.

¹³-Answer pages 11-12.

¹⁴-Answer page 13.

The Rodman article speculates on the difficulty of defining the term and concludes that an adventure game is centered around a character (character development in particular) with a universal goal and is not combat-based.

The Archmage article contradicts Rodman placing importance on weapons and battle rather than character development. At the end of the Archmage article, there is an invitation to criticize or disagree with the article.

The Federico article seems to agree with Archmage that combat is an important part of adventure games.

Lastly, the Aplin article takes the position that "story" is not the essential defining element of an adventure game while maintaining that not all games are adventure games. Aplin admits that usually an adventure game has a story and involves solving puzzles, exploring, overcoming obstacles, etc.

According to the Examiner's best evidence, then, there is some disagreement among game aficionados¹⁵ as to the true meaning of the term "adventure game". How then must one proceed? Of course, the first place one should look to determine the meaning of "adventure game" as it is used in the Applicant's claims is the

¹⁵-The articles appear to be from personal web pages of computer gaming "fans".

Applicant' specification. There one will find a perfectly reasonable definition¹⁶ which agrees with Rodman and Aplin. This definition should be sufficient to exclude pinball games, and golf simulators, as well as ordinary "video games".

At page 14 of the Answer, the Examiner cites In re McLaughlin as forgiving a certain amount of hindsight in forming an obviousness rejection. However, the Examiner is doing exactly what McLaughlin states cannot be done. The Examiner is using knowledge obtainable only from the applicant's disclosure to reconstruct an adventure game using features of other non-related references.

In light of all of the above, it is submitted that the claims are in order for allowance, and the Applicant respectfully requests that the Board direct the Examiner to allow the case.

Respectfully submitted,



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November 8, 2002

¹⁶-Specification page 12.